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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/590,585	06/08/2000	Simon J. Mantell	PC10334A	1013

23913 7590 10/08/2002

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EXAMINER

LEWIS, PATRICK T

ART UNIT PAPER NUMBER

1623

DATE MAILED: 10/08/2002

6

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/590,585

Applicant(s)

MANTELL ET AL.

Examiner

Patrick T. Lewis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-40 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-24 and 30, drawn to compounds of formula (I), classified in class 536, subclass 28.6.
 - II. Claim 25, drawn to a method of treating a mammal with a A2a receptor agonist, classified in class 514, subclass 43.
 - III. Claim 26, drawn to a method of treating a mammal having an inflammatory disease with a compound of formula (I), classified in class 514, subclass 43.
 - IV. Claims 27-28, drawn to a method of treating a mammal having a respiratory disease with a compound of formula (I), classified in class 514, subclass 43.
 - V. Claim 29, drawn to a method of treating a mammal having septic shock, male erectile dysfunction, hypertension, etc. with a compound of formula (I), classified in class 514, subclass 43.
 - VI. Claims 31 and 33-38, drawn to a compound of formula (II), (VI), (X), (IX), (XII), (XIII), (XXI), or (XXII), classified in class 536, subclass 28.6.
 - VII. Claims 32-33 and 38-40, drawn to a compound of formula (XXIV), (XXV), (XXVI), (XXVII), or (XX), classified in class 544, subclass 1.

The inventions are distinct, each from the other because of the following reasons:

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2. Inventions (I and II), (I and III), (I and IV) and (I and V) are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the compounds of Invention I may be used to practice any of the methods of Inventions II, III, IV, or V.

3. Inventions (I and VI), (I and VII), and (VI and VII) are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different structural cores. A search for compounds of Invention I will not necessitate a search for compounds for Inventions VI or VII, further, a reference rendering Group I obvious will not render Inventions VI or VII obvious. Applicant is not entitled to examination of multiple compounds. This indeed would place undue burden upon the examiner in charge of this application.

4. Inventions (II and III), (II and IV), (II and V), (III and IV), (III and V), and (IV and V) are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are drawn to the treat of distinct conditions and have different modes of operation.

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5. Inventions (II and VI), (II and VII), (III and VI), (III and VII), (IV and VI), (IV and VII), (V and VI), and (V and VII) are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the compounds of Inventions VI and VII are not employed in the methods of Inventions II, III, IV, or V.

6. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper. It would indeed impose an undue burden upon the examiner in charge of this application if the instant restriction and species requirement were not advances as set forth herein.

7. In the event applicant elects the invention of Group V, applicant is required to elect a species in accordance with the provisions set forth below:

Claim 29 generic to a plurality of disclosed patentably distinct species wherein disease/condition is species **A** (septic shock), **B** (male erectile dysfunction), **C** (hypertension, stroke, cerebral ischaemia, peripheral vascular disease, or post-ischaemic reperfusion injury), **D** (epilepsy), **E** (diabetes), **F** (rheumatoid arthritis), **G** (multiple sclerosis), **H** (psoriasis, dermatitis, or allergic dermatitis), **I** (eczema), **J** (ulcerative colitis, Crohns disease, inflammatory bowel disease), **K** (*Helicobacter pylori* gastritis), **L** (non-*Helicobacter pylori* gastritis), **M** (non-steroidal anti-inflammatory drug-induced damage to the gastro-intestinal tract), **N** (psychotic disorder), or **O** (wound

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healing). Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

8. In the event applicant elects the invention of Group VI, applicant is required to elect a species in accordance with the provisions set forth below:

Claim 31 generic to a plurality of disclosed patentably distinct species wherein compound is species **P** (II), **Q** (VI), **R** (X), **S** (IX), **T** (XII), **U** (XIII), **V** (XXI), or **W** (XXII).

9. In the event applicant elects the invention of Group VII, applicant is required to elect a species in accordance with the provisions set forth below:

Claim 32 generic to a plurality of disclosed patentably distinct species wherein compound is species **A1** (XXIV), **B1** (XXV), **C1** (XXVI), **D1** (XXVII), or **E1** (XX).

10. Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

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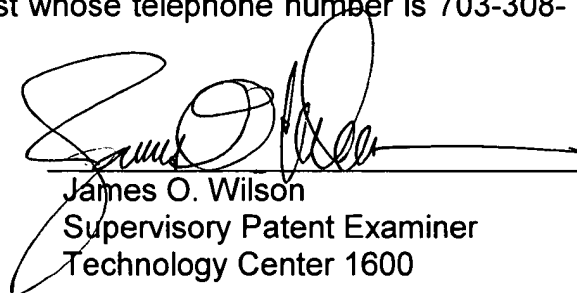
Contacts

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick T. Lewis whose telephone number is 703-305-4043. The examiner can normally be reached on M-F 8:00 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson can be reached on 703-308-4624. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3014 for regular communications and 703-305-3014 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Patrick T. Lewis, PhD
Examiner
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James O. Wilson
Supervisory Patent Examiner
Technology Center 1600

ptl
October 1, 2002